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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,035	06/14/2005	Rosanne Welcher	09138.0072	9296

63432   7590   09/25/2009
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EXAMINER
NAGPAUL, JYOTI

ART UNIT	PAPER NUMBER
1797	

MAIL DATE	DELIVERY MODE
09/25/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-59</u> is/are pending in the application.

    4a) Of the above claim(s) <u>56</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-55 and 57-59</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

Election/Restrictions

1.   Applicant's election with traverse of claims 1-55 and 57-59 in the reply filed on

July 9, 2009 is acknowledged. The traversal is on the ground(s) that the office action

has failed to demonstrate that searching Groups I and II together would impose a

serious burden. This is not found persuasive because if the common matter of the

independent claims is well known and the remaining subject matter of each claim differs

from that of the others without there being any unifying novel inventive concept common

to all, then clearly there is lack of unity of invention. (Refer to MPEP 1850)

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   **Claims 1-55 and 57-59** are rejected under 35 U.S.C. 102(b) as being anticipated

by Bernstein (US 5696887).

Bernstein teaches establishing an automated slide processing system having an

automated process operation capability to which robotic sample process functions,

functions such as assay protocols, laboratory tasks or test procedures programmed by

robotic device or computer (15), are responsive. (Refer to Col. 7, Lines 33-68)

Bernstein further teaches providing an input parameter capability, operator, independent

of the automated process operation capability, computer (15). Bernstein further teaches

accomplishing sample process parameter input to the input parameter capability without

interrupting the automated process operation capability. (Refer to (Col. 27, Lines 57-58)

Bernstein further teaches independently storing at least a portion of the parameter input,

assay protocols, for later access (Refer to Col. 23, Lines 3-20) Bernstein further

teaches establishing stored parameter process data. (Refer to Col. 23, Lines 3-20 and

Table 2) The system further comprises automatically accessing at least a portion of the

stored parameter process data, tasks, through operation of the automated process

operation capability. (Refer to Table 2) Bernstein further teaches automatically

replicating at least a portion of the stored parameter process data, tasks, for use by the

automated process operation capability. (Refer to Table 2) The system further teaches

integrating the automated process operation capability and the replicated portion of the

stored parameter process data, tasks, to create an interspersial robotic control

functionality. (Refer to Col. 23, Lines 3-20 and Table 2) (Refer to Col. 5, Lines 45-55)

The computer of Bernstein further teaches controlling at least some of the robotic

sample process functions, tasks, in response to the interspersial robotic control

functionality and automatically processing at least one sample through operation of the

robotic sample process functions at a process time independent of the time the step of

accomplishing slide process parameter input to the input parameter capability without

interrupting the automated process operation capability is accomplished. (Refer to Col

23, Lines 5-20, Table 2 and Col. 27, Lines 58-68 to Col. 28, Lines 1-5) Bernstein further

teaches arranging a plurality of slides (540) on a movable carrier retainment assembly

(10), robotic arm, applying a reagent to the plurality of slides (refer to col. 14, Lines 12-16) and automatically staining the plurality of slides (540). (Refer to Col. 14, Lines 11-24) Bernstein further teaches a step of establishing a local area network electronically connected to the automated sample processing system comprises the step of incorporating a system having a feature selected from a group consisting of: an Ethernet element, a token ring element, an arcnet element, a fiber distributed data interface element, an industry specification protocol, a bluetooth-based element, a shared common link element, a transmission control protocol internet protocol communication element, a packetized information protocol, a shared protocol, a proprietary protocol, and a layered protocol exchange system. (Refer to Col. 8, Lines 1-12) Bernstein further teaches the step of automatically, computer (15) identifying the plurality of slides (540). Bernstein further teaches step of providing an input parameter capability independent of the automated process operation capability comprises the step of utilizing a multitasked central processing unit resource. (Refer to Col. 27, Lines 15-68) Bernstein further teaches the step of establishing an automated sample processing system comprises the step of establishing a stand alone automated slide processing system and wherein the step of providing an input- parameter capability independent of the automated process operation capability comprises the steps of: utilizing a separate full function computer programmed to accomplish the input and electronically connecting the separate full function computer to the stand alone automated slide processing system. (Refer to Col. Col. 27, Lines 58-68) (Refer to Col 23, Lines 5-20, Table 2 and Col. 27, Lines 58-68 to Col. 28, Lines 1-5) The step of

utilizing a remote link to the automated sample processing system comprises the step of

utilizing a remote link having a feature selected from a group consisting of: an internet

connection element, a telephone line connection element, a wireless communication

element, and a detachable memory element. (Refer to Col 23, Lines 3-20) The step of

providing an input parameter capability independent of the automated process operation

capability comprises the step of utilizing a batch processing parameter input

functionality. (Refer to Col. 27, Lines 57-68) Bernstein further teaches the step of

automatically processing for certain samples is initiated at a time after the completion of

the step of accomplishing slide process parameter input for the certain samples. The

time selected from a group consisting of: at least about one hour, at least about three

hours, at least about eight hours, at least about one day, at least about two days, and at

least about one week. (Refer to Col. 2, Lines 17-24) The system further comprises the

step of accomplishing sample process parameter input to the input

parameter capability without interrupting the automated process operation

capability comprises the step of inputting at least some process scheduling

information. (Refer to Col. 27, Lines 15-68) Bernstein further teaches the step of

providing for administrator control, operator, over at least some aspects of the

automated sample processing system, equivalent to override. (Refer to Col. 7, Lines 17-

18) Bernstein further teaches the step of storing at least a portion of the parameter

input on a physically independent memory, floppy, comprises the step of storing at least

a portion of the parameter input at a location remote from the automated sample

processing system. Bernstien further teaches the step of determining operational

readiness of at least a portion of the automated sample processing system functionality

comprises the step of electronically determining operational availability of an automated

sample processing system aspect selected from a group consisting of:

an individual sample element, a defined group of samples, a physically grouped

collection of samples, a slide drawer component, an stand alone automated slide

processing system, a slide stainer system element, and a user initiated prompt

signal. (Refer to Col. 25, Lines 45-68) Bernstein further teaches the step of integrating

the automated process operation capability and the replicated portion of the stored

parameter process data to create an interspersial robotic control functionality comprises

the step of interleaving a plurality of process operations. (Refer to Col. 27, Lines 15-68)

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JYOTI NAGPAUL whose telephone number is (571)272-

1273. The examiner can normally be reached on Monday thru Friday (10:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jyoti Nagpaul/
Examiner, Art Unit 1797